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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,911	09/18/2001	Arun B. Kulkarni	J&J-2049	8616

27777 7590 08/05/2003
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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,911

Applicant(s)

KULKARNI ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Acknowledgment is made of the amendment filed 5/19/03. Claims pending are 1 and 3-16. Claim 2 has been cancelled. Claims 1, 3, 5, 9 and 13 have been amended.

With respect to Claim 16, it is noted that Claim 16 was not originally presented for examination and, therefore, was not included in the rejection. See attached Exhibit A (a copy of the last page of the original claims). However, Claim 16 appears to be anticipated by Lyle et al. because the reference teaches the claimed range of active ingredient as discussed in the previous Office Action (paper #4, p. 2, section 2).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. The rejection of Claims 1, 5, 6, 9 and 12-15 under 35 U.S.C. 102(e) as being anticipated by Lyle et al. is maintained for the reasons of the record. Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Lyle et al. for the reasons of the record.

2. Claims 1, 3-6, 9, 13, 15 and 16 are rejected under 35 U.S.C. 102(e) or 102(a) as being anticipated by Picken, Jr. et al. (US 6,194,372) supplied by the Applicant.

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Picken, Jr. et al. teach sprayable gel compositions capable of liquefying upon shearing, said compositions containing 1-4% of a clay thickener, 5-26% of a solvent including glycols, alcohols and dibasic esters such as ethanol, propylene glycol and the like, builders such as EDTA, sodium hydroxide, phosphate and silicate, citrus water distillate, surfactants, coloring agents, terpens and other additives. See Abstract; col. 1, lines 61-65; col. 3-4. With respect to Claims 13, 15 and 16, the reference teaches 0.5-2% of a preservative. The preservatives of Picken, Jr. et al. include chloroxylenol which is a conventional anti-fungal and anti-microbial agent. See col. 4, lines 43-45.

Thus, Picken, Jr. et al. teach each and every limitation of Claims 1, 3-6, 9, 13, 15 and 16.

Claim Rejections - 35 USC § 103

3. The rejection of Claims 3, 4, 7, 8, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Lyle et al. is maintained for the reasons of the record.

4. Claims 7, 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picken, Jr. et al.

Picken, Jr. et al. applied as above. With respect to Claims 7 and 8, the reference teaches from about 5% to about 26% by weight of the solvent, but fails to teach the claimed concentration of "from about 30 percent to about 65 percent by weight" (Claim 7) and "from about 35 percent to about 50 percent by weight" (Claim 8). However, the determination of optimal or workable concentration of the solvent by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired viscosity of the composition. Further, the

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recitation "about 5 to about 26%" in the reference allows for concentrations slightly above 26% and the recitation of "about 30%" or "about 35%" in the instant claims allows for concentrations slightly below 30 and 35%, so the ranges overlap. See *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). With respect to Claims 11 and 12, the reference is silent about the concentration of the [viscosity] builder. However, the determination of optimal or workable concentration of the viscosity builder by routine experimentation is obvious absent showing of criticality of the claimed concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired viscosity of the composition.

Response to Arguments

5. Applicant's arguments filed 5/19/03 have been fully considered but they are not persuasive.

The Applicant argues that Lyle et al. do not disclose a shear thinning composition as recited in the amended Claim 1. In response, it is noted that since the composition of Lyle et al. contains the claimed ingredients, it is inherently shear thinning. Since the only alleged distinction between applicants' claim and reference is recited in functional language, it is incumbent upon applicants, when challenged, to show that the composition disclosed by reference does not actually possess such characteristics. In re Ludtke, 169 USPQ 563 (CCPA 1971).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (703) 308-2927.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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8/3/03



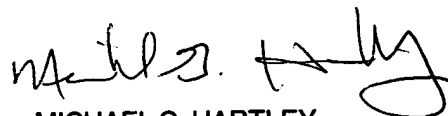

MICHAEL G. HARTLEY
PRIMARY EXAMINER

Exhibit A

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15. The composition according to claim 14 wherein the amount of active ingredient ranges from about 0.25 percent to about 0.75 percent by weight, based on the total weight of the composition.

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FOR FILING